

REMARKS

By the present amendment, claim 13 has been amended. Upon entry of this amendment and the following election, claims 13-23 are pending and claims 1-12 and 26 are withdrawn.

Support for the amendment to claim 13 can be found throughout the specification. For example, compounds that fall within the scope of claim 13, where $q=3$, include Compounds 237, 238, and 249, described on page 58 and in Examples, 42, 43, and 54, respectively.

No new matter has been added.

RESTRICTION REQUIREMENT

The Restriction Requirement under 35 U.S.C. §§ 121 and 372 asserts that the application contains claims directed to more than one inventive concept. The requirement further asserts that the above-referenced application does not contain claims that are "so linked as to form a single inventive concept." Accordingly, the Office Action requires that Applicants elect between the following groups:

- I. Claims 13-23, allegedly drawn to a product of formula IA; and
- II. Claims 1-12 and 26, allegedly drawn to a method of inhibiting mitotic kinesin Eg5.

Furthermore, the Office raises a species requirement to which the claims shall be restricted if no generic claim is held allowable.

Election

Applicants elect Group I, i.e., Claims 13-23, allegedly drawn to a product of formula IA, with traverse. In order to be responsive to the species requirement, Applicants elect Compound No. 237. Of the elected group, claims 13-19, 22, and 23 read on the elected species.

Traverse

Notwithstanding the election of Group I and Compound 237 in order to be responsive to the Restriction and Species Requirement, Applicants respectfully traverse the Examiner's requirement for restriction.

Applicants note that this application is a national stage application, and therefore under unity of invention practice the Examiner must establish that the claims lack unity of invention under PCT Rule 13.1 and 37 C.F.R. 1.475.

In particular, the Examiner is reminded that in determining unity of invention, the criteria set forth in 37 C.F.R. 1.475 must be considered. Specifically, Applicants note that 37 C.F.R. 1.475 provides:

Unity of invention before the International Searching Authority, the International Preliminary Examining Authority, and during the national stage.

(a) An international and a national stage application shall relate to one invention only or to a group of inventions so linked as to form a single general inventive concept ("requirement of unity of invention"). Where a group of inventions is claimed in an application, the requirement of unity of invention shall be fulfilled only when there is a technical relationship among those inventions involving one or more of the same or corresponding special technical features. The expression "special technical features" shall mean those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art.

(b) An international or a national stage application containing claims to different categories of invention will be considered to have unity of invention if the claims are drawn only to one of the following combinations of categories:

- (1) A product and a process specially adapted for the manufacture of said product; or
- (2) A product and process of use of said product; or
- (3) A product, a process specially adapted for the manufacture of the said product, and a use of the said product; or
- (4) A process and an apparatus or means specifically designed for carrying out the said process; or

(5) A product, a process specially adapted for the manufacture of the said product, and an apparatus or means specifically designed for carrying out the said process.

(c) If an application contains claims to more or less than one of the combinations of categories of invention set forth in paragraph (b) of this section, unity of invention might not be present.

(d) If multiple products, processes of manufacture, or uses are claimed, the first invention of the category first mentioned in the claims of the application and the first recited invention of each of the other categories related thereto will be considered as the main invention in the claims, see PCT Article 17(3)(a) and § 1.476(c).


(e) The determination whether a group of inventions is so linked as to form a single general inventive concept shall be made without regard to whether the inventions are claimed in separate claims or as alternatives within a single claim.

Thus, in stating the restriction requirement, the requirement must state why unity of invention is lacking under 1.475. In the instant situation, the requirement does not refer to 1.475, and does not indicate that the requirement is proper in view of this rule.

The requirement does point to PCT Rule 13.1 and PCT Rule 13.2, and asserts that the special technical feature of the invention of Groups is not novel in view of the CAPLUS abstract accession No. 1963:462322 for Chemische Berichte (1963), 96(8), 2199-205, alleging that this document teaches compounds that teaches the core structure of the claimed compounds. However, the requirement does not discuss 1.475(b)(1), which permits an international or a national stage application containing claims to different categories of invention to have unity of invention if the claims are drawn only to one of the following combinations of categories including a product and a process specially adapted for the manufacture of said product.

In view of the foregoing, Applicants respectfully request withdrawal of the restriction requirement. If there should be any questions, the Examiner is invited to contact the undersigned at the telephone number listed below.

Respectfully submitted,
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